

REMARKS

The Applicants have amended the claims to attend to the informalities noted by the Examiner. In particular, claim 19 has been amended to depend from claim 21, and claims 20 and 21, the word "in," has been replaced with the words "made of." No change in the scope of the claims have been made. The Applicants believe that these amendments place the claims in better condition for appeal, and request entry of these amendments.

With respect to the substantive rejections, the Examiner has rejected claim 21 as obvious over Morr in view of Merrill arguing that it would have been obvious of anyone with ordinary skill to manufacture the device of Morr from a radiation treated ultra high molecular weight polyethylene in view of Merrill to improve the wear resistance of the device. The Applicants respectfully disagree because one of ordinary skill would not be so motivated. In particular, the Morr rasp includes metallic blades 18 for contacting the bone. Since the metallic blades are sufficiently hard to cut bone without the added steps of incorporating a plastic material and treating that plastic material to make it hard enough to cut bone, one of ordinary skill would not be motivated to combine Morr and Merrill as suggested by the Examiner. Moreover, if one of ordinary skill combined Morr and Merrill, they would not arrive at the present invention. The plastic components of Morr, if treated as in Merrill, would be hardened, but do not contact the bone and, therefore, would not contact the bone as in the claimed invention. To make this distinction more clear, the Applicants have amended claims 20 and 21 to state that the ancillary for removing bone comprises "a part made of plastic material which is to come into contact with bone to be removed, said part being adapted to remove the bone when said ancillary is used." The Applicants believe that this amendment places the claims in condition for allowance, or at least in better condition for appeal, and request entry of these amendments.

With respect to claim 19, the Examiner argues that it would be obvious for one of ordinary skill to manufacture the device of Morr with a part made of shape memory material because such is only a matter of selecting a known material based on its suitability for the Applicants' intended use of a matter of design choice. The Applicants respectfully disagree because the Examiner cites no art indicating that treated polyethylene would be suitable for

the rasping function contemplated by the Applicants' claims. The only suggestion that this material would be suitable for cutting bone comes from the Applicants' disclosure. In this regard, the rejection appears to improperly rely on hindsight to reconstruct the claimed invention.

The Examiner has rejected claims 12, 13, 15, 16, 18, 20, and 21 as obvious over Howard in view of Merrill. The Applicants respectfully disagree because Howard does not disclose a device having a plastic part that is adapted to remove bone. As discussed in regard to the rejection of claim 21, the Applicants' invention is distinguished from the prior art in that it employs a plastic part which contacts the bone to be removed and is adapted to remove the bone, claims 20 and 21 have been amended to emphasize this distinction. Howard merely discloses a guide to which a bone saw may be attached by way of a magnet. The bone saw contemplated by Howard is one existing in the art and does not contemplate the rasp claimed by the Applicants. Consequently, even if one of ordinary skill were to combine Howard and Merrill as suggested by the Examiner, they would not arrive at the present invention.

As in the case of Morr, there is nothing within Howard or Merrill that would suggest that these two patents be combined. Merrill relates to a femoral implant and Howard relates to a guide used with a blade saw. The Examiner sites no basis for the suggestion that a device that could be used to rasp bone as claimed or could be inherently manufactured in a manner to remove bone. The device shown in Howard is merely a guide and does not contemplate the removal of bone without the addition of a bone saw.

In light of the foregoing, the Applicants respectfully request reconsideration of the Examiner's rejections and issuance of a Notice of Allowance for claims 12, 13, and 15-21.

Respectfully submitted,


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